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TO:	**Mail Stop Amendments** **USPTO**
FAX NO.:	**(571) 273-8300**
FROM:	**Mark R. Woodall** **KRAMER & AMADO, P.C.**
DATE:	**May 22, 2006**
SUBJECT:	**U.S. Patent Application** **Title: VIDEO ENCODING METHOD USING A WAVELET DECOMPOSITION** **Serial No.: 09/912,130** **Attorney Docket No.: FR 000076**
PAGES:	**INCLUDING COVER PAGE (8)**

Message: Submitted herewith are the following:

- Transmittal Form
- Request for Reconsideration (6 pages)

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission: 7

Application Number	09/912,130
Filing Date	July 24, 2001
First Named Inventor	Boris Felts, et al.
Art Unit	2613
Examiner Name	Shawn S. An
Attorney Docket Number	FR 000076

ENCLOSURES *(Check all that apply)*

- ☐ Fee Transmittal Form
  - ☐ Fee Attached
- ☐ Amendment/Reply
  - ☐ After Final
  - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Reply to Missing Parts/ Incomplete Application
  - ☐ Reply to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation Change of Correspondence Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) _____
  - ☐ Landscape Table on CD
- ☐ After Allowance Communication to TC
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☐ Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
- ☐ Proprietary Information
- ☐ Status Letter
- ☑ Other Enclosure(s) (please identify below):

Request for Reconcideration

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Kramer & Amado, P.C.		
Signature	Terry W. Kramer		
Printed name	Terry W. Kramer		
Date	May 22, 2006	Reg. No.	41,541

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature	Russell A. Belicek		
Typed or printed name	Russell A. Belicek	Date	5-22-06

MAY 2 2 2006

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Boris Felts et al.
For	:	VIDEO ENCODING METHOD USING A WAVELET DECOMPOSITION
Serial No.:	:	09/912,130
Filed	:	July 24, 2001
Art Unit	:	2613
Examiner	:	Shawn S. An
Att. Docket	:	FR 000076
Confirmation No.	:	4032

REQUEST FOR RECONSIDERATION

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Request is in response to the Office Action dated March 7, 2006, and is believed to be fully responsive to each point of the rejection raised therein. Accordingly, favorable reconsideration and allowance of all the claims are respectfully requested in view of the following remarks.

Claims 1-3 are pending in the present application of which claim 1 is independent.

The Office Action rejects claim 1 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,671,413 to Pearlman et al. (hereinafter "Pearlman") in view of U.S. Patent No. 6,625,321 to Li et al. (hereinafter "Li"). The Office Action objects to claims

2 and 3 as being dependent upon a rejected base claim 1. Applicant respectfully traverses the above rejection for at least the reasons set forth below.

Pearlman and Li, considered singly or in combination, fail to disclose, teach, or suggest the claimed invention as recited in independent claim 1 and the Office Action fails to establish a motivation to combine Pearlman and Li as required.

Claim 1 recites an encoding method "characterized in that, for the estimation of probabilities of occurrence of the symbols 0 and 1 in said lists at each level of significance, four models, represented by four context-trees, are considered, these models corresponding to the LIS, LIP, LSP and sign." Applicant respectfully submits that Li does not disclose, teach, or suggest this subject matter. The subject matter quoted above relates to estimating weighted probabilities of a symbol using a context tree in order to reduce model redundancy and maintain reasonable complexity. In contrast, Li estimates the probability of significance of coefficient w_i using a state machine and therefore does not attain the performance benefits of using context-trees, as recited in claim 1. See col. 6, ln. 59-64. Moreover, Li considers only the pattern of past insignificance and significance under the same context in order to estimate the probability of significance, not four models, represented by four context-trees, as recited in claim 1. See col. 7, ln. 3-7. The Office Action correctly concedes that Pearlman does not disclose, teach, or suggest this subject matter. Consequently, it is respectfully submitted that Pearlman and Li fail to disclose, teach, or suggest, singly or in combination, an encoding method "characterized in that, for the estimation of probabilities of occurrence of the symbols 0 and 1 in said lists at each level

of significance, four models, represented by four context-trees, are considered, these models corresponding to the LIS, LIP, LSP and sign," as recited in claim 1.

At least by virtue of the failure of both Pearlman and Li to disclose, teach, or suggest the above quoted subject matter of claim 1, the Office Action has failed to establish a *prima facie* case of obviousness as required under 35 U.S.C. § 103. Claims 2 and 3 depend from allowable claim 1 and are also allowable over Pearlman in view of Li at least by virtue of their dependencies.

Moreover, Applicant further submits that the Office Action fails to demonstrate a proper motivation to combine Pearlman and Li. It is impermissible for an Examiner to engage in hindsight reconstruction of the prior art using Applicant's claims as a template and selecting elements from references to fill the page. Rather, prior art references may be modified or combined to render obvious a subsequent invention only if there was some suggestion or motivation to do so derived from the prior art itself, the nature of the problem to be solved, or the knowledge of one of ordinary skill in the art. *Sibia Neurosciences*, 225 F.3d 1349, 1356 (Fed. Cir. 2000); *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998).

Here, the Office Action summarily states that "it would have been obvious to a person of ordinary skill in the art employing an encoding method as taught by Pearlman to incorporate Li's teaching as above for estimating the probabilities of occurrence of the symbols 0 and 1 in each level of significance for optimizing rate-distortion performance." The Office Action does not support this statement with a suggestion or motivation derived from the prior art itself, the nature of the problem to be solved, or the knowledge of one of ordinary skill in the art. Therefore, it is

respectfully submitted that the Office Action fails to provide a proper motivation to combine Pearlman and Li.

When the only suggestion of a claimed feature on the record is that of the pending application, a rejection under § 103 is improper. *See In re Laskowski*, 10 USPQ2d 1397 (Fed. Cir. 1989). Here, that appears to be the case. Applicant respectfully asserts that only by the impermissible use of hindsight knowledge of Applicant's own disclosure would the Examiner have acquired a motivation to combine the teachings of the cited references according the precise combination including certain elements and excluding certain others as necessary to achieve the claimed invention.

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *See In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." *Kotzab*, 55 USPQ2d at 1316 (quoting *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983) ("[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the

insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher")).

Here, the Office Action's unsupported assertion that a person having an ordinary level of skill in the art at the time the application was filed would be motivated to combine the particularly selected combination of teachings in Pearlman and Li "for estimating the probabilities of occurrence of the symbols 0 and 1 in each level of significance for optimizing rate-distortion performance" appears to find no support anywhere other than in Applicants disclosure. In other words, Applicant respectfully asserts that the Office has engaged in impermissible hindsight reasoning in order to arrive at the alleged motivation to combine the particular teachings of Pearlman and Li.

At least by virtue of the failure of the Office Action to establish a motivation to combine Pearlman with Li as required, a *prima facie* case of obviousness has not been established under 35 U.S.C. § 103. Claims 2 and 3 depend from allowable claim 1 and are also allowable over Pearlman in view of Li at least by virtue of their dependencies.

For at least the forgoing reasons, Applicant respectfully requests that the rejection be withdrawn.

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

While we believe that the instant amendment places the application in condition for allowance, should the Examiner have any further comments or suggestions, it is respectfully

Application No: 09/912,130
Attorney's Docket No: PHFR 000076

requested that the Examiner telephone the undersigned attorney in order to expeditiously resolve any outstanding issues.

In the event that the fees submitted prove to be insufficient in connection with the filing of this paper, please charge our Deposit Account Number 50-0578 and please credit any excess fees to such Deposit Account.

Respectfully submitted,
KRAMER & AMADO, P.C.

Date: May 22, 2006

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